

### **REMARKS**

Claims 12, and 20-25 are currently pending to which the Examiner provides several rejections which are listed below in the order in which they are addressed:

- I. Claims 12, and 20-25 are allegedly anticipated under 35 U.S.C. § 102(e) by United States Patent Publication No. 2002/0160378 To Harper et al., taken with evidence of Kagaya et al., *Nucleic Acids Research* 27:470-478 (1999) and United States Patent Publication No. 2004/0078852 To Thomashow et al.
- II. Claims 12, and 20-25 are rejected under 35 U.S.C. § 112 ¶ 1
  - A. The specification allegedly fails to comply with the written description requirement as the claims allegedly recite new matter.
- III. Claims 12, and 20-25 are rejected under 35 U.S.C. § 112 ¶ 2
  - A. The claims are allegedly indefinite.

**I. The Applicants Invented Before Harper et al.**

As the Examiner is well aware, a single reference must disclose each limitation of a claim in order for that reference to anticipate the claim. *Atlas Powder Co. v. E.I. du Pont De Nemours & Co.*, 224 U.S.P.Q. 409, 411 (Fed. Cir. 1984). This criterion is not met with the Harper et al reference, even when taken with the teachings in Kagaya et al. and Thomashow et al. In order to qualify as prior art under Section 102, a reference must be shown to have invented the claimed element before the Applicants. This is not the case here.

The Examiner has cited Harper et al. as an anticipatory reference. The Examiner should note that Harper's filing date (August 24, 2001) is less than one year before the Applicants' provisional filing (August 2, 2002). Consequently, it is proper to show prior invention by the Applicant using a 37 CFR 1.132 declaration.

The Applicants herein provide “The Thomashow Declaration” with a laboratory notebook page showing identifying a RAV1 gene response to cold stress using a microarray gene expression technique. This data is attested to have been performed before August 24, 2001 (i.e., before the Harper et al. filing date). Consequently, the Applicants invented the claimed embodiment before Harper et al. Further, as described below, Harper et al. did not disclose RAV1 in the cited priority documents.

The Applicants have searched for, and cannot find, the equivalent of Harper’s SEQ ID NO:2316 in the United States Provisional Application No. 60/227,866, filed on August 24, 2000. Specifically, the ‘866 provisional application does not contain the designation “RAV1” nor does it contain the sequence configuration ATGGAATCG AGTAGCGTTG which represents position 92 – 110 of the Applicant’s Figure 11 (i.e., SEQ ID NO:1). Additionally, the ‘866 provisional application does not refer to Accession No. AB 013886 or At1g13260. While nineteen (19) “DNA-binding proteins” were identified in the ‘866 provisional application, none were related to RAV1.

The Applicants have searched for, and cannot find, the equivalent of Harper’s SEQ ID NO:2316 in the United States Provisional Application No. 60/264,267, filed on January 26, 2001. Specifically, the ‘267 application does not contain the designation “RAV1” nor does it contain the sequence configuration ATGGAATCGAGTAGCGTTG which represents position 92 – 110 of the Applicant’s Figure 11 (i.e., SEQ ID NO:1). Additionally, the ‘267 provisional application does not refer to Accession No. AB 013886 or At1g13260. Further, a search for “DNA-binding proteins” also revealed no teaching of these types of proteins.

The Applicants have searched for, and cannot find, the equivalent of Harper’s SEQ ID NO:2316 in the United States Provisional Application No. 60/300,111, filed on June 22, 2001. Specifically, the ‘111 application does not contain the designation “RAV1” nor does it contain the sequence configuration ATGGAATCGAGTAGCGTTG which represents position 92 – 110 of the Applicant’s Figure 11 (i.e., SEQ ID NO:1). Additionally, the ‘111 provisional application does not refer to Accession No. AB 013886 or At1g13260. Further, a search for “DNA-binding proteins” also revealed no teaching of these types of proteins.

Since Harper et al. does not anticipate the pending claims the Applicants respectfully request that the Examiner withdraw the rejection.

**II. Claims 12, and 20-24 Comply With The Written Description Requirement**

The Examiner states that the claims contain “new matter” because:

It is maintained that the specification does not provide written description support for sequences that are at least 95% homologous to SEQ ID NO: 1.

*Office Action, pg. 3.* The Applicants disagree. Nonetheless, without acquiescing to the Examiner's argument but to further the prosecution, and hereby expressly reserving the right to prosecute the original (or similar) claims, Applicants have deleted “95% homologous” from Claim 12. Claim 25 is concomitantly canceled. This amendment is made not to acquiesce to the Examiner's argument but only to further the Applicants' business interests, better define one embodiment and expedite the prosecution of this application.

The Examiner states that the claims contain “new matter” because:

The specification does not provide written description support for the claimed method in which SEQ ID NO:1 would be expressed only after treating with drought or stress.

*Office Action, pg. 4.* The Applicants disagree. Nonetheless, without acquiescing to the Examiner's argument but to further the prosecution, and hereby expressly reserving the right to prosecute the original (or similar) claims, Applicants have amended Claim 12 to delete “cold or”. The Examiner is requested to note that this embodiment is now separately claimed in new Claims 26-31. This amendment is made not to acquiesce to the Examiner's argument but only to further the Applicants' business interests, better define one embodiment and expedite the prosecution of this application.

The Applicants respectfully request that the Examiner withdraw the present rejection.

**III. Claims 12 And 20-25 Are Not Indefinite**

The Examiner submits that Claim 12 is incomplete because:

Claim 12 is missing the essential step of expressing the dehydration regulatory genes. The last step only results in a plant expression cold or drought regulatory gene. ... It is unclear why only drought gene would be expressed.

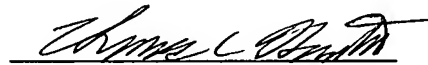
*Office Action*, pg. 5. The Applicants disagree because it is believed that the above amendments and new Claim 26 moot this rejection.

The Applicants respectfully request that the Examiner withdraw the present rejection.

**CONCLUSION**

The Applicants believe that the arguments and claim amendments set forth above traverse the Examiner's rejections and, therefore, request that all grounds for rejection be withdrawn for the reasons set above. Should the Examiner believe that a telephone interview would aid in the prosecution of this application, the Applicants encourage the Examiner to call the undersigned collect at 617.984.0616.

Dated: 10/1/2007



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